

REMARKS

Applicants have reviewed the Application in light of the Office Action mailed January 28, 2009. Claims 23-44 are pending in this Application. Claims 23-26, 31, 36, and 38-44 stand objected to for informalities. Claims 23 and 41-44 stand rejected under 35 U.S.C. § 112, second paragraph; Claim 23 stands rejected under 35 U.S.C. § 101; and Claims 23-25, 27-30, 32, 35, and 41-44 stand rejected under 35 U.S.C. § 103(a). Claims 23-26 and 28-44 have been amended. No new matter was presented. Applicants respectfully request reconsideration and favorable action in this case.

Amendment to the Specification

The Examiner noted that the Title of the Application was not descriptive. Applicants have amended the Title as suggested by the Examiner. *See* Page 2 of the current paper.

Objections under 37 C.F.R. § 1.83(a)

The drawings stand objected to under 37 C.F.R. § 1.83(a). The Examiner alleges that the “mobile device” and “base station” recited in the Claims must be included in the figures or cancelled from the claims. Applicants respectfully disagree.

37 C.F.R. § 1.81 states, “The applicant for a patent is required to furnish a drawing of his or her invention *where necessary for the understanding of the subject matter sought to be patented*” (emphasis added). *See* also 35 U.S.C. § 113. Accordingly, the law does not require that each and every element of the claims always be illustrated.

Here, a separate drawing showing a mobile radio device and a base station would not be necessary for an understanding of the subject matter of the pending Claims. The Specification discloses a mobile radio device and a base station, for example, at Paragraph [0002]. Thus, one of ordinary skill in the art would understand the mobile radio device and base station recited in the pending Claims. Moreover, the Examiner has presented no evidence to suggest that a separate drawing showing the mobile radio device and/or the base station would be necessary to someone of ordinary skill in the art for understanding.

Applicants believe that corrected drawing sheets are not necessary in light of the foregoing remarks and respectfully request the objection to the drawings be withdrawn.

Claim Objections

Claims 23-26, 31, 36, and 38-44 stand objected to due to informalities. Applicants amend Claims 23-26, 31, 36, and 38-44 and believe the amendments overcome these objections. Applicants respectfully request the objections to Claims 23-26, 31, 36, and 38-44 be withdrawn.

Rejections under 35 U.S.C. § 112

Claims 23, 26, and 41-44 stand rejected by the Examiner under 35 U.S.C. § 112, second paragraph, as being indefinite and failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants amend Claims 23, 26, and 41-44 to overcome these rejections and respectfully request full allowance of Claims 23, 26, and 41-44 as amended.

Rejections under 35 U.S.C. § 101

Claim 23 was rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Applicants respectfully submit that Claim 23 as originally written was directed to statutory subject matter. However, to advance prosecution, Applicants have amended Claim 23 to overcome the rejection. In particular, Applicant has amended Claim 23 to include statutory subject matter performing the various steps of Claim 23. Applicants respectfully request withdrawal of the § 101 rejections.

Rejections under 35 U.S.C. § 103

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on ex post reasoning. *KSR*, 127 S.Ct. at 1742. In addition, evidence that such a combination was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), citing *KSR*, 127 S.Ct. at 1741.

Claims 23-25, 27-30, 32, 35, and 41-44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicants' Admitted Prior Art (*APA*) in view of Great Britain Patent GB 2 350 984 by Winga Ho (*Ho*). Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

The Alleged APA is not Prior Art

A premise of the Examiner's rejection of Claims 23-25, 27-30, 32, 35, and 41-44 is that portions of Applicants' Specification are Admitted Prior Art. For example, the Examiner alleges that Paragraphs [0002], [0007], and [0009] of the Specification of the present application is allegedly admitted prior art. (Office Action, Pages 6-7). However, neither the cited portion of the Specification of the instant application, nor any other portion of the Specification makes an explicit or implicit admission that what is therein stated is prior art. While the Specification may provide an indication regarding what information is known by an inventor prior to invention, the mere existence of such information does not make it prior art under applicable patent law. To qualify as prior art, information must meet one of the statutory definitions of prior art under 35 U.S.C. § 102. For example, there is no evidence that the information set forth in the Specification was known or invented by another prior to invention recited in the present claims, meaning the information cannot be deemed prior art under 35 U.S.C. § 102(a) or (e). As another example, there is no evidence that the information set forth in the specification was known more than a year before filing of the present application, and thus cannot be deemed prior art under 35 U.S.C. § 102(b). Accordingly, nothing in the Specification can be deemed prior art without evidence indicating that it is prior art under applicable law. For at least these reasons, the alleged *APA* is not prior art, meaning *Alleged APA*, alone or in combination with *Karr*, cannot render obvious Claims 23-25, 27-30, 32, 35, and 41-44.

Alleged APA and Karr Do Not Disclose All Claimed Limitations of the Recited Claims

Even assuming the alleged *APA* may properly be cited as prior art, the alleged *APA* and *Ho* do not disclose each and every element of the pending Claims. For example, amended Independent Claim 23 recites:

A method for transmitting control parameters on a physical channel between a mobile radio device and a base station in a cellular network, comprising:

providing with the control parameters a packet number for identifying a data packet; and

source coding, via a source coding device integral to the mobile radio device, the packet number together with at least one further of the control parameter for the transmission,

wherein the control parameters are used for controlling a packet-oriented data transmission between the mobile radio device and the base station; and

transmitting, via a transmission device, the at least one further of the control parameter and packet number between the mobile radio device and the base station.

As noted by the Examiner, the alleged *APA* fails to teach or suggest source coding the packet number together with at least one control parameter for transmission. *See* Office Action, Page 7. *Ho* also fails to teach or suggest the above-recited element. Referring Page 2, Lines 6-32, as relied upon by the Examiner, *Ho* discloses “transmitting the encoded packet data to said receiving digital system as a packet including a header having a packet number and a tag identifying the encoding information used to encode the packet data.” While *Ho* makes mention of a packet number, *Ho* makes no mention of control parameter(s), and hence fails to teach or suggest that the packet number *is source coded together with a control parameter* for transmission, as recited in Claim 23. Furthermore, *Ho* discloses:

During transmission of data from one digital system to the other, the sending digital system 12 loads data into frames. The sending digital system 12 also compresses and/or encrypts (scrambles), hereinafter “encodes”, the data using encoding information known to the receiving system. **Once encoded, the data frames are encapsulated with headers...** (Page 3, Lines 24-29. Emphasis added).

Thus, it appears that *only* the data frames are encoded and then subsequently encapsulated with headers. Therefore, *Ho* separately or as combined with the alleged *APA* does not teach or suggest the elements of Independent Claim 23.

For analogous reasons, *APA* and/or *Ho* also fail to teach or suggest similar elements recited in Independent Claims 41-44. Accordingly, the cited reference(s) cannot render Independent Claims 41-44 obvious.

For at least these reasons, Independent Claims 23, 41-44 and all claims that respectfully depend therefrom, are patentably distinct over the alleged *APA* and/or *Ho*. Applicants respectfully request withdrawal of the rejections under 35 U.S.C § 103(a) and full allowance of all pending claims.

Information Disclosure Statement

Applicants submit herewith a new Information Disclosure Statement and PTO Form 1449 for the Examiner's review and consideration. The Commissioner is authorized to charge the \$180.00 fee to Deposit Account No. 50-2148 of Baker Botts L.L.P.

Applicants submit this reference was previously submitted in an Information Disclosure Statement for consideration; however, the Examiner did not consider because the date was not included on the PTO Form 1449.

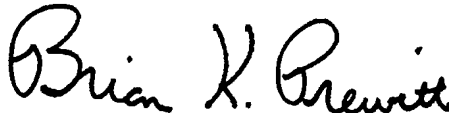
CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants enclose a Petition for Extension of Time for two months and authorize the Commissioner to charge the \$490.00 Extension fee to Deposit Account No. 50-2148 of Baker Botts L.L.P. Applicants believe there are no additional fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2684.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorney for Applicants



Brian K. Prewitt
Reg. No. 60,135

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SEND CORRESPONDENCE TO:
BAKER BOTTS L.L.P.
CUSTOMER ACCOUNT NO. **31625**
512.322.2684
512.322.8383 (fax)